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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,004	06/29/2001	Aruna Nathan	ETH-1572	1514

27777 7590 08/12/2002  
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EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/12/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

09

Application No. 896004	Applicant(s) ARNOLD et al		
Examiner MPC Levy	Group Art Unit 1616	6	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 8/31/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-58 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-58 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Receipt is acknowledged of IDS, Declaration, and Drawings of 8/31, 10/09, 8/30.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 31, 56, drawn to medical devices, wax, classified in class 600, subclass 36+.
- II. Claim 13, drawn to bioactive devices, classified in class 424, and subclass 409.
- III. Claim 14, drawn to medical devices, polyester, classified in class 523, subclass 105.
- IV. Claims 15, 16, drawn to coated medical devices, classified in class 424, subclass 78.09.
- V. Claims 17-30, drawn to bone replacement device, classified in class 424, subclass 602.
- VI. Claims 32-48; 57, drawn to compositions, classified in class 71, subclass 64.01.
- VIII. Claims 49-55, 58, drawn to seeds, classified in class 504, subclass 100.

Because the Groups I-VII have acquired a separate status in the art as shown by their different classification, and their recognized divergent subject matter, and the search for any one group is not required for any other group, and because a search and examination of the entire application would place an undue burden on the Examiner, the present restriction requirement is proper for examination purposes.

Art Unit: 1616

This application contains claims directed to the following patentably distinct species of the claimed invention: species of polybasic acid: acid, anhydride, ester, acid halides or activated esters.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-4, 7-24, 26-35, 38-58 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of ester: glycolide, caprolactone, carbonate, dioxanone, dioxepan.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 14-16, 48, 53 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of filler: calcium phosphate, calcium carbonate, barium carbonate, calcium sulfate, barium carbonate, calcium sulfate, barium sulfate.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17-19, 22-30 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of bioactive: growth factor-resperidone.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 13, 22, 27, 32-44, 47, 54, 57 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of device: those of claim 31: sutures—stents—plates.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-12, 31 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of replacement: demineralized bone, --plasma, -marrow, fragments (as of claim 24).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17-30 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Additional species requirement may be instituted—for example, claim 54 does not provide specific compounds.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Because the above restriction/election requirement is complex, a telephone call to applicant's agent to request an oral election was not made. See MPEP Sec. 812.01

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 305-4556 for regular communications and 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy:mv  
August 8, 2002



NEIL S. LEVY  
PRIMARY EXAMINER